

## REMARKS

Claims 1-4 and 6-20 are now pending in the application. Claims 5 and 21-24 have been canceled. Dependent Claim 6 has been rewritten in independent form including the limitations of Claim 1 and also now-canceled Claim 5. Claims 1, 6, 11 and 15 are independent claims.

### Section 112, first paragraph Rejection

Claim 6 was rejected under 35 USC 112, first paragraph as failing to comply with the enablement requirement. Specifically, paragraph 3 of the Action states that the “Examiner could not find description in the specification to enable one skilled in the art to implement the limitation of claim 6, that is, the method wherein certain files *must* exceed a certain size for a search of the library to occur”.

Applicant has amended paragraph [0021] of the specification to include such recitation. No new matter has been added as this subject matter was included in the specification as filed, in Claim 6.

Reconsideration and withdrawal of the Section 112, first paragraph rejection are respectfully requested.

### Section 112, second paragraph Rejection

Claims 1-24 were rejected under 35 USC 112, second paragraph, as indefinite. Specifically, paragraph 5 of the Action states that as to Claims 1, 10<sup>1</sup> and 15 “...‘uploading the specified media file to a predetermined server....’ – it is not clear from where the media file is uploaded”.

Applicant has amended each of Claims 1, 11 and 15 so as to recite that the specified media file is uploaded *from an appropriate drive*”. This language is supported by the specification as filed at least at paragraphs [0021], [0023] and [0024].

Reconsideration and withdrawal of the Section 112, second paragraph rejection are respectfully requested.

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<sup>1</sup> Applicant assumes that Claim 10 was listed inadvertently, and that the rejection applies to Claims 1, 11 and 15. If this assumption is incorrect, Applicant requests clarification in the next communication.

### Section 103(a) Rejections

Claims 1, 3-5, 7-11 and 13-14 were rejected under 35 USC 103(a)<sup>2</sup> as being unpatentable over US Patent 5,568,181 (Greenwood et al.) in view of US Patent 5,857,072 (Crowle); Claims 2 and 12 were rejected as being unpatentable over Greenwood and Crowle and further in view of US Patent Publication Number 2002/0138619 A1 (Ramalay); Claim 6 was rejected as being unpatentable over Greenwood and Crowle; Claims 15-18 (and, it appears, Claims 19-20) were rejected as being unpatentable over US Patent 6,356,948 (Barnett et al.) in view of Greenwood; and Claims 20-24 were rejected as being unpatentable over US Patent Publication Number 2001/0032246 A1 (Fardella) in view of Crowle.

In view of the foregoing claim amendments and the following discussion, the each of rejections is respectfully traversed and reconsideration is requested.

### Independent Claims 1, 6 and 11

Independent Claim 1, as amended herein, is directed to a method for distributing media files over a computer network. The method recites receiving at a server an electronic message that includes one or more recipients designated to receive said electronic message along with a specified media file, identifying the specified media file, searching a library of frequently transmitted media files to determine whether the specified media file exists in the library, and, if the specified media file exists in the library, transmitting a copy of the specified media file to the recipients, or, if the specified media file does not exist in the library, uploading the specified media file from a corresponding drive to a predetermined server and transmitting, to the recipients, a copy of the specified media file from the predetermined server.

Independent Claim 11 is directed to a computer readable media having encoded thereon a plurality of instructions causing a processor to perform each of the steps recited in Claim 1.

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<sup>2</sup> It is respectfully noted that paragraph 7 of the Action states that Claims 1, 3-5, 7-11 and 13-14 are rejected under 35 USC 102(b) as being *anticipated* by Greenwood in view of Crowle. Applicant assumes that this is in fact a 103(a) rejection and has prepared this response under that assumption.

Greenwood is directed to “a video distribution management system that utilizes a shared video library and a wide area network to deliver video files to local caches on the local area networks serving a subset of local viewing stations”...“a locally stored preface of a video file can be immediately viewed on the local area network while the balance of the video file is transmitted from the remote video library”. (see Abstract).

As acknowledged in the Action, Greenwood fails to teach or even suggest a method for distributing media files over a computer network including the step of “receiving at a server an electronic message that includes one or more recipients designated to receive (1) said electronic message *along with* (2) a specified media file”.

The Action takes the position, however, that Crowle teaches a “data distribution system where an electronic message includes one or more recipients designated to receive the message along with a specified media file...[and that] it would have been obvious...to implement Crowle’s messaging system into Greenwood to allow Greenwood to communicate with a plurality of client computers” – the Action continues that “one would have been motivated to do utilize this implementation in order to distribute data to multiple network computer locations simultaneously”.

Applicants respectfully submit that Crowle fails to even teach or suggest the teachings acknowledged to be absent from Greenwood. Crowle is directed to a system for distributing data *with advanced notice to intended recipients*. Specifically, Crowle ‘generates a first message indicating the data comprising the data distribution and the network computer locations intended to receive the data distribution’ and then sends the file records. “Data server 10 initially sends a message 26 entitled WHAT-U-GOT to all network client locations”, the client locations then respond to that message with IVE-GOT messages, and “data distribution system 10 then generates a FILE-HEADER message that indicates the specific data included in the data distribution as well as the network computer locations intended to receive the data distribution” (col. 5, line 32- col. 6, line 3) – data server 10 then sends a series of FILE RECORDS (MSG\_FILE\_RECORD).

Crowle, like Greenwood, does not teach or suggest a method for distributing media files over a computer network including the step of ‘receiving at a server an electronic message that includes one or more recipients designated to receive *the electronic message along with the specified media file*’.

For at least this reason, Applicant respectfully submits that independent Claims 1 and 11, as amended herein, are patentable over the teachings of Greenwood and Crowle.

In addition, of course according to the Manual on Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*

Therefore, since the only suggestion of a method of distributing media files over a computer network, the method including the step of receiving at a server an electronic message that includes one or more recipients designated to receive the electronic message *along with* the specified media file, is found in Applicant’s disclosure, the Office Action relies upon impermissible hindsight in the Section 103(a) rejection. Reconsideration and withdrawal of the rejection of amended independent Claims 1 and 11 is therefore respectfully requested.

Again, Applicants respectfully submit that Claims 1 and 11, as amended herein are patentable over the cited art. Reconsideration is requested.

Dependent Claim 6 has been rewritten in independent form, and recites all of the limitations of independent Claim 1 and further recites that the method further comprises the step of detecting a size of the specified media file attached to the electronic message (former dependent Claim 5), and that the search of the library is performed *only if the specified media file exceeds a predetermined size*.

In rejecting Claim 5, the Action states (paragraph 12 of Action) that “Greenwood discloses...detecting the size of the specified media file attached to the electronic message [col. 6 < lines 43-48>]. In addition, in rejecting Claim 6, the Action states (paragraph 22 of Action) that

“it is well known and expected in the art to include a minimum file size as a search parameter to refine and increase the efficiency of a file search” and that therefore it would have been obvious “to include the minimum file size as a parameter in Greenwood’s cache and library search system when the system searches for the video files in the video library”.

Applicant respectfully submits that the analysis of the Action appears to be based on a misreading of the claims. Claim 6 requires that the method recited therein “detect a size of the specified media *attached to the electronic message*”, and to “search the library *only if* the media file exceeds a predetermined size”. Column 6, lines 43-48 of Greenwood (cited in paragraph 12 of the Action) simply notes that the “relationship between the bandwidth available on WAN 13, the size of the video file, and the rate at which the video file is played back are used to determine the size of the preface (i.e., the ‘initial portion of the video file having a duration which is adequate to permit the transmission of the balance of that video file from the remote library 11 to the local cache over the WAN 13’; see column 6, lines 19-21) required for speed match playback”. Greenwood uses bandwidth, size and rate to determine the size of the “preface” needed to provide sufficient time for transmission of the remainder of the video file. This simply does not correspond, or teach or suggest, the element recited in Claim 6, which recites a method that includes a step of detecting a size of the specified media file attached to the electronic message, and in which a search of the library is performed only if the specified media file (attached to the electronic message) exceeds a predetermined size.

For at least the foregoing reasons, and for those submitted above with regard to independent Claim 1, Applicants respectfully submit that independent Claim 6, as amended herein, is patentable over the cited art. Reconsideration is requested.

Independent Claim 15

Independent Claim 15, as amended herein, is directed to a system for transferring media files from a sender to multiple recipients including a server associated with a first computer, and an electronic messaging system adapted to operate over the server, the messaging system being adapted to generate electronic messages of a first type which have at least one media file attached thereto and which designate a plurality of recipients, and the messaging system being further adapted, when an electronic message of the first type is sent from the first computer, to (a) identify the attached file, (b) search a library of frequently transmitted files to determine whether the attached file exists in the library, and (c) transmit, if the attached file exists in the library, a copy to the recipients, together with the electronic message, or, if the specified file does not exist in the library, upload the specified file from an appropriate drive to a predetermined server and transmit to the recipients the specified file from the predetermined server together with the electronic message.

In rejecting independent Claim 15 based upon the alleged teachings of Barnett and Greenwood, the Action acknowledges (paragraphs 26 and 27 of Action) that Barnett “does not teach” that (1) the data are media files or (2) searching a library of frequently transmitted files to determine whether the attached file exists in the library, and (a) transmit, if the attached file exists in the library, a copy to the one or more recipients together with the electronic message or, (b) if the specified file does not exist in the library, upload the specified file from an appropriate drive to a predetermined server and transmit to the one or more recipients the specified file from the predetermined server together with the electronic message.

The Action then relies upon the alleged teachings of Greenwood stating that it would have been obvious “to modify Barnett’s data distribution system to include Greenwood’s library cache functionality for the purpose of increasing Barnett’s ability to manage and distribute media files”.

Again, Greenwood is simply directed to “a video distribution management system that utilizes a shared video library and a wide area network to deliver video files to local caches on the local area networks serving a subset of local viewing stations”...“a locally stored preface of a video file can be immediately viewed on the local area network while the balance of the video file is transmitted from the remote video library”. (see Abstract).

As noted above by Applicant, Greenwood fails to teach or even suggest a system for transferring media files from a sender to multiple recipients in which after a search of a library is performed, the attached file is send *together with* the electronic message to the identified recipients.

For at least the foregoing reasons, Applicants submit that independent Claim 15, as amended herein, is patentable over the cited art. Reconsideration is respectfully requested.

Dependent Claims 2-4, 7-10, 12-14 and 16-20 are believed to be clearly patentable for all of the reasons indicated above with respect to Claims 1, 6, 11 and 15, one or another from which they depend, and even further distinguish over the cited references by reciting additional limitations.

Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is made that the Examiner telephone the Applicants' attorney at (908) 518-7700 in order that any outstanding issues be resolved.

Respectfully submitted,

  
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Karin L. Williams  
Registration No. 36,721

**PLEASE CONTINUE TO SEND ALL CORRESPONDENCE TO**

Mayer, Fortkort & Williams PC  
251 North Avenue West, Second Floor  
Westfield NJ 07090

(908) 518-7700  
(908) 518-7795 fax